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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,728	05/22/2001	Gary K. Starkweather	1026-037/MMM 160226.1	1235
41505	7590	12/14/2004	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			LE, BRIAN Q	
			ART UNIT	PAPER NUMBER
			2623	
DATE MAILED: 12/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/862,728	STARKWEATHER, GARY K.	
	Examiner Brian Q Le	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07/23/2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) 5, 6, 13, 14, 20, 24, 25 and 27 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4, 7-12, 15-19, 21-23 and 26 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 06/25/04.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **RESTRICTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 7-12, 15-19, 21-23 and 26, drawn to a system for a document digitizing method comprising the optical scanning document, forming, storing a digitized image file, and forming and storing a text file wherein each digitized image file is correlated with a corresponding text file with a common file names and are distinguished by file extensions classified in class 382, subclass 176.
  - II. Claim 27, drawn to a method of retrieving the digitized image file for a document comprising the storing digitized image files associate with text files, searching the text files to identify a first text string, searching the text files having the first text string to identify any having a second text string, and providing access to the digitized image files corresponding to the text files identified as having the first and second text strings, classified in class 382, subclass 305.
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as optical scanning document, forming, storing a digitized image file, and forming and storing a text file wherein each digitized image file is correlated with a corresponding text file with a common file names and are distinguished by file extensions. Invention II has separate utility such as the storing digitized image files associate with text files, searching the text files to identify a first text string, searching the text files having the first text string to identify any having a second text string, and

providing access to the digitized image files corresponding to the text files identified as having the first and second text strings. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Newly submitted claim 27 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 27 teaches the concept toward the method of retrieving the digitized image file and granting the access to the digitized image files corresponding to text strings which is different from claims 1-4, 7-12, 15-19, 21-23 and 26 which teach the concept of digitizing document, forming and storing digitized image file in correlation with text file of a document wherein the digitized image file and text file have common file names and distinguished by file extension.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 27 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Response to Amendment and Arguments**

6. Applicant's amendment filed July 23, 2004, has been entered and made of record.
7. Applicant's arguments, see 'Remarks', filed July 23, 2004, with respect to the rejection(s) of claim(s) 1, 12, 18 and 23 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gary K. Starkweather, "PEDISTAL, A Personal Document Imaging System", Microsoft Research, October 2000.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 1-4, 7-12, 15-19, 21-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVito U.S. Patent No. 5,825,943 and further in view of Gary K. Starkweather, "PEDISTAL, A Personal Document Imaging System", Microsoft Research, October 2000.

Regarding claim 1, DeVito teaches a document digitizing method of digitizing a document in printed form (column 3, lines 9-12 and FIG. 1), comprising:

Optically scanning the document (FIG. 3, element 200);

Forming (FIG. 2) and storing (memory) a digitized image file from the optically scanned document (FIG. 1, element 106 and column 3, lines 15-18);

Optically recognizing under computer control characters in the optically scanned document (column 3, lines 45-50); and

Forming and storing a text file of the optically recognized characters in document (column 3, lines 24-30).

DeVito does not explicitly teach the correlation of the text file corresponding to the digitized image file of the document and wherein the digitized image file and text file have common file names and are distinguished by appropriate file extensions. Gary teaches a document imaging system wherein each digitized image file is correlated with a corresponding text file and wherein the digitized image file and text file have common file names and are distinguished by appropriate file extensions (page 5, Item No. 4). Modifying DeVito's method of digitizing document according to Gary would able to create a correlation between the image file and the corresponding text file of the document to enhance retrieving and storing processing. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify DeVito according to Gary.

For claim 2, DeVito further teaches the method which the document includes plural pages and a separate digitized image file is formed for each page of the document (column 2, lines 32-37).

Referring to 3, DeVito also teaches the method which a separate text file is formed for each page of the document (display portion of data set shown for each page) (column 2, lines 30-37).

For claim 4, DeVito discloses the method which the document includes plural pages and a separate text file is formed for each page of the document (column 2, lines 30-37).

Regarding claim 7, DeVito further teaches the method which corresponding digitized image files and text files are correlated by a mapping table or algorithm (TIC Table) (column 2, lines 39-41).

Referring to claim 8, DeVito shows the method comprising retrieving a digitized image file for a document based upon a text string (search phrase for the text file) in the text file corresponding to the digitized image file (column 2, lines 21-28).

For claim 9, DeVito includes the teaching of the method which the digitized image file is compressed and of a lossless image file format (column 3, lines 55-60).

Regarding claim 10, DeVito further discloses the method which the text file is of a simplified file format based upon ASCII characters (column 2, lines 13-15).

Referring to claim 11, DeVito also discloses the method which optical character recognition is applied to all text characters in the optically scanned document (column 2, lines 12-15).

Regarding claim 12, please refer back to claim 1 for the explanation. In addition, DeVito teaches the computer readable medium to process the claimed limitations (FIG. 1, element 106).

For claim 15, please refer back to claims 2-5 for further explanation.

Regarding claims 16-17, please refer back to claims 9-10 respectively for further explanation.

For claim 18, please refer back to claims 1 and 12 for further explanations.

Referring to claim 19, DeVito teaches the method, which providing access to the digitized image files includes allowing a user to selectively display any of the digitized image files corresponding to the text files identified as having the selected

text string (FIG. 2, elements 208, 210, 212, 214, and 216).

For claim 21, DeVito teaches the method in which searching the text files to identify any having a selected text string includes specifying multiple separate text strings and searching the text files in a batch to identify any text files having any of the separate text strings (FIG. 2, elements 210, 212, and 214).

For claim 22, DeVito teaches the method in which the text files have file names, the method further comprising storing the file names of the text files identified as having the selected text string (column 2, lines 38-44).

For claim 23, please refer back to claim 1 for the teaching. Also, DeVito teaches the software to perform claimed limitations (column 3, lines 24-25).

For claim 26, please refer back to claim 8 for the explanation.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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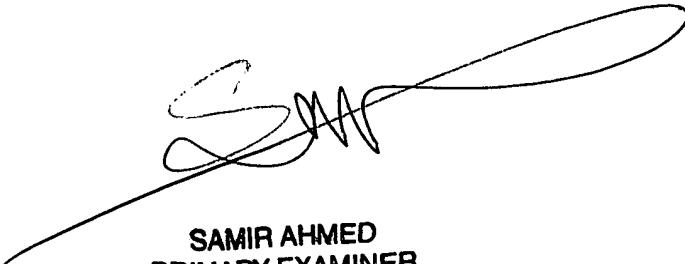
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 703-305-5083. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5397 for regular communications and 703-308-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC Customer Service whose telephone number is 703-306-0377.

BL  
November 30, 2004

  
**SAMIR AHMED  
PRIMARY EXAMINER**